

**REMARKS**

Claim 1 is amended herein. Support is found, for example, at page 12, lines 1-5. No new matter is presented.

**I. Response to Objection to the Specification**

In paragraph 5 of the Office Action, the disclosure is objected to essentially for the reasons of record presented in the rejection under 35 U.S.C. § 112, 1<sup>st</sup> paragraph, for lack of enablement. Specifically, the Examiner asserts that there is contradiction in the specification between the results provided for Example 2 and Comparative Examples 1, 3 and 5 such that, given Applicant's teachings in the specification for suitable densities of the polymers, Comparative Examples 1, 3, and 5 should have acceptable result. The Examiner states that since these Comparative Examples do not have satisfactory results, undue experimentation is necessary to determine what the invention actually is, what parameters are unaccounted for that result in the inadequacies of the comparative examples and what features are actually responsible for the success of certain embodiments of the invention. According to the Examiner, the lack of guidance on this issue contributes to the need for undue experimentation.

Applicants respectfully traverse the rejection as improper.

Since the Examiner has withdrawn the previous objections to the specification and the previous §112, first paragraph, rejection based on lack of enablement, Applicants submit that it is not clear under what basis the Examiner is making the current objection to the specification. The Examiner maintains that “undue experimentation” would be required to practice the invention, which is a standard of enablement, but the Examiner has not made a lack of enablement rejection. For at least this reason the objection to the specification is improper.

Further, Applicants submit that Example 2 of the present invention employs LDPE having a density of  $0.919 \text{ g/cm}^3$ , which is within the claimed range and none of Comparative Examples 1, 3 and 5 referred to by the Examiner employ LDPE within the claimed range (compare Table 1 and Table 2 at page 21 of the specification). Thus, the Examiner's assertion is unfounded.

Applicants have previously pointed out that the claimed invention is sufficiently enabled by the specification as written and adequately described. The extent to which the Examiner relies on the results of the Examples to assert the disclosure is inconsistent, Applicants submit that the fact that densities taught by Applicants may not produce the results of the same level of superiority as in the case of the present claims where LDPE has a density equal to or less than  $0.919 \text{ g/cm}^3$ , does not render embodiments of other densities inconsistent, much less not adequately described or non-enabled. Applicants are permitted to selectively claim embodiments described and enabled in the disclosure over the course of prosecution. There is no prohibition against doing so.

Accordingly, Applicants respectfully request withdrawal of the objection to the specification.

## **II. Response to Claim Rejections under 35 U.S.C. § 103**

In paragraph 7 of the Office Action, claims 1, 2 and 5-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over US '848 in view of Ishikawa et al and Lee (U.S. 5,428,093).

Applicants respectfully traverse the rejection.

Claim 1 as amended recites that no filler is added to the resin composition.

According to the present invention, because specific amounts of specific polyethylenes having different densities are mixed and no filler is used in the supporting substrate, the effects particular to the present invention can be achieved.

As the Examiner admits, Ludwig is silent with respect to the supporting substrate having an uneven portion on one side. Although Ishikawa discloses that an uneven surface is formed on one side of the polyolefin resin based film, in the case of the adhesive tape described in Ishikawa, when a base film of the adhesive tape is prepared, a filler (calcium carbonate) is added to a resin constituting the base film in a large amount of 10 to 20 % by weight. This is an embodiment which corresponds to Comparative Example 6 of the present invention, in which the effect of the present invention is not achieved. Accordingly, since the resin composition forming the substrate in the invention contains no filler, the present invention is not obvious from the combination of Ludwig and Ishikawa in which a large amount of filler is substantially required. In other words, there is no apparent reason for one of ordinary skill in the art to modify or combine the references with a reasonable expectation of success in achieving the claimed invention.

Applicants further note that although Example 2 and Comparative Example 3 of Ishikawa do not contain a filler, since polyethylene resins having the same densities (HDPE, density:  $0.96\text{g/cm}^3$ ) are blended in these examples, they are different from the present invention.

Accordingly, Applicants respectfully request withdrawal of the rejection.

### **III. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

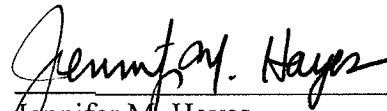
AMENDMENT UNDER 37 C.F.R. § 1.114(c)  
Application No.: 10/662,440

Attorney Docket No.: Q77488

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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